

### **REMARKS**

Claims 1-5, 7, 9, 11, 12, and 22-70 are pending. By this amendment, claims 1-5 and 7 are amended to conform their language to the exact language of claims 1-5 and 7 of U.S. Patent 5,609,938, which is the subject of this reissue proceeding. New claims 71-91 are added. Claim 71 is an exact duplicate claim of claim 6 of U.S. Patent 5,609,938. New claims 72-91 are directed to methods disclosed in U.S. Patent 5,609,938. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance are respectfully requested.

**A. Submission of PTO Form 1449**

On page 3 the Office Action requests applicant supply a PTO Form 1449 listing the references printed on U.S. Patent 5,609,938. The requested form is attached. Applicant notes that a PTO Form 1449 containing this information was submitted with an Information Disclosure Statement filed November 24, 2003.

**B. Rejection Based on Recapture**

Claims 1-5, 7, 9, 11-12, 22-70 are rejected under 35 U.S.C. §251 for improper recapture of claimed subject matter deliberately canceled. This rejection is respectfully traversed.

Claims 9, 7-12 and 22-70 are canceled and their rejection is moot. Claims 1-5 and 7 are amended to precisely reflect the claim language of issued claims 1-5 and claim 7 of U.S. Patent 5,609,938, which is the subject of this reissue proceeding. Applicant respectfully requests that the rejection of claims 1-5 and 7 under 35 U.S.C. §251 be withdrawn.

**C. Rejection Under 35 U.S.C. §112 First Paragraph**

Claim 5 is rejected under 35 U.S.C. §112, ¶1 as containing subject matter that was not described in the specification. This rejection is respectfully traversed.

Claim 5 is amended to the exact language of issued claim 5 in U.S. 5,609,938, which is the subject of this reissue proceeding. Namely, the original limitation of the allowed claim of a "layer of perforated transfer adhesive" has been restored to the claim and the Markush group added by earlier amendment has been removed. Accordingly, Applicant respectfully requests that the rejection of claim 5 under 35 U.S.C. §112, ¶1 be withdrawn.

**D. Rejections Under 35 U.S.C. §103(a)**

Claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 under 35 U.S.C. §103(a) over Hill (U.S. 4,673,609). This rejection is respectfully traversed.

Claims 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 31-41 and 67 are canceled, and their rejection is moot. Claims 1, 5, and 7 are amended to reflect the exact language of claims 1, 5 and 7 of U.S. Patent 5,609,938, which is the subject of this reissue proceeding. In view of the fact that the Hill reference was considered in the original prosecution of the '938 patent, Applicant respectfully requests withdrawal of the rejection of claims 1, 5, 7 and 9 under 35 U.S.C. §103(a).

Claims 3, 4, 23, 31-33 and 42, 43, 44, 45, 46-48, 49, 50, 51-56, 57-67 and 69-70 are rejected under 35 U.S.C. §103(a) over Hill in view of Frey (U.S. 1,199,882). This rejection is respectfully traversed.

Claims 23, 31-33, 42, 43, 44, 45, 46-48, 49, 50, 51-56, 57-66 and 69-70 are canceled and their rejection is moot. Claims 3 and 4 are amended to reflect the exact language of issued claims 3 and 4 of U.S. Patent 5,609,938, which is the subject of this reissue proceedings. As both the Hill and Frey references were considered in the prosecution of U.S. Patent 5,609,938, Applicant respectfully requests withdrawal of claims 3 and 4 under 35 U.S.C. §103(a).

Claims 11 and 12 are rejected under 35 U.S.C. §103(a) over Hill in view of Mallik and Rosenthal. Claims 11 and 12 are canceled and their rejection is moot.

Claims 2 and 68 are rejected under 35 U.S.C. §103(a) over Hill in view of Bogner (DE 28 38 028). This rejection is respectfully traversed.

Claim 68 is canceled and its rejection is moot. Hill is directed to panels which comprise a substrate of transparent or translucent material having designs imposed on the surface and Bogner is directed to the printing of fabric by printing machines, thus it is not reasonable to assume that one skilled in the art of printing signs on a hard impervious, transparent or translucent surface would be familiar with the printing of fabric which is typically very flexible, usually opaque and which typically absorbs dye solutions. The materials have very different physical properties. In Section XIII, on page 16, the Office Action states that "Bogner deals with a common problem of manipulation of sheets that need to have designs printed on them." This statement suggests very similar physical properties of the materials to be printed; however, in reality the two materials have very different physical

properties. In addition, there is no motivation or suggestion in either Hill or Bogner to support combination of these references. Furthermore, claim 2 has amended depends from patentable claim 1 and for this additional reason, claim 2 is patentable. For these reasons, claim 2 is patentable. Accordingly, Applicant requests withdrawal of the rejection of claim 2.

**E. Examiner's General Remarks**

In Section VI, on pages 11-13, the Office Action further discusses recapture. As noted above, Applicant believes that the present amendments conforming claims 1-5 and 7 to the language of issued claims in U.S. 5,609,938 and cancellation of other claims, renders the recapture issue moot.

In Section X, on pages 14-16, the Office Action discusses Applicant's arguments regarding lack of support in the specification for certain claims of the Hill reissue patent. Applicant maintains his arguments regarding this issue. However, in view of the above-disclosed amendment, Applicant believes that the claims as currently presented can be allowed to pass to issue without resolving the Hill reissue question.

Applicant believes that the Examiner's comments in items VII, XI, XII, and XIII on pages 11-16 have either been addressed by the claim amendments provided herein and discussed above or alternatively by cancellation of claims.

**F. New Claims and other Remarks**

Applicant has added new claims 72-75 directed to a method of use of the device. As the reissue application was filed within two years of the issuance of U.S. Patent 5,609,938, Applicant is entitled to method of use claims which are supported by the specification and not previously claimed. The method of use recited in claims 72-75 is supported variously in the specification and Applicant directs the Examiner's attention to U.S. 5,609,938 column 7, line 59 to column 8, line 9 which is exemplary of the support in the specification for method of use claims.

As one embodiment, the display panel assembly 10 is applied to the outside surface of a window 32 of a bus 34 or other vehicle (see eg. FIG. 3). In this example, the transparent panel 12 is at the outermost side of the display panel assembly 10 and the innermost surface of panel 16 will be secured by an adhesive (not shown) to the exterior surface of window 32.

Alternatively, any or all of the panels 12, 14 and 16 may comprise self-adhesive or static cling film, such as, for example, poly-vinyl chloride sheet material, such that the completed panel assembly may be removably applied to a surface (i.e. inside or outside surface) of a window 32.



To passengers seated inside the bus 34, the display panel assembly 10 appears transparent as the perforations or through-holes permit the transmission of light therethrough without significant reflection. Thus persons inside the bus 34 typically will not notice the presence of the display panel assemblies 10 on the bus windows 32.

Applicant has further added New claims 76-91 for a method of forming a display assembly. Figures 7 and 8, column 9, lines 23-44 of the specification and the above referenced passage from column 7 line 59 to column 8, line 9 of the specification are exemplary of support in the specification for claims 76-91.

Further regarding claims canceled in this response, Applicant maintains his belief that such subject matter is patentable and reserves the right to present such claims and/or amended versions of such claims in future proceedings regarding this invention.

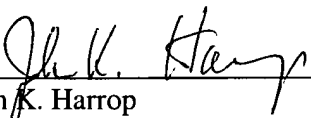
#### CONCLUSION

In view of the above amendments and remarks, Applicant respectfully submits that the application is in a condition for allowance. Accordingly, allowance of the claims as amended herein is requested.

Should the Examiner believe that anything further is desired in order to place the application in condition for allowance the Examiner is invited to contact Applicant's undersigned representation at the telephone number listed below.

Respectfully submitted,

Date: April 5, 2005

  
John K. Harrop  
Registration No. 41,817  
**Andrews Kurth LLP**  
1701 Pennsylvania Ave, N.W.  
Suite 300  
Washington, DC 20006  
Tel. (202) 662-3049  
Fax (202) 662-2739

Attachment: PTO Form 1449